

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-17 are pending in this application. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE OBJECTIONS TO THE CLAIMS HAVE BEEN OVERCOME

The objections to claims 1-17 have been overcome in light of the following amendments and/or arguments:

III. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 1-17 were rejected as allegedly being obvious Gijutsu et al.(JP 11-323258 - "Gijutsu") in view of Sjøholm et al. (US 5,948,661 - "Sjøholm"). The applicants request reconsideration of this rejection for the following reasons. (The response below is essentially the same response previously provided, however, the applicants are also concurrently filing a Rule 132 declaration by Dr. Bong Keun SONG).

While the applicants still assert that no showing of unexpected results is necessary as Gijutsu and Sjøholm does not establish that the applicants' claims to be obvious, in order to expedite prosecution, the applicants are submitting additional data which further shows the unique nature of the applicants' claimed invention.

Additional experiments with other mediators other than the claimed mediators using the same process as Example 1 of the present application were conducted to show that the other non-inventive mediators have little favorable effect on the yield of the claimed reaction. (See also attached Rule 132 declaration by Dr. Bong Keun SONG)

As can be seen from the following Table, mediators (other than the claimed mediators), which are conventional well-known mediators in the art as can be shown in *Chem. Res. Toxicol.* **1996**, 9, 476-483, (see especially, Table 2 and left column of page 480), did not favorably affect the yield of the phenolic polymer, that is, they led to little polymerization of cardanol. On the other hand, the claimed mediators have resulted in much increased yield in the polymerization as can be seen from the Tables 2 and 3 of the present application.

Conc. of mediators	30μ M		74μ M	
Mediators	Yield (%)	Mean molecular weight(M _w) (Measurement with GPC)	Yield (%)	Mean molecular weight(M _w) (Measurement with GPC)
Trifluoperazine Dihydrochloride	0	-	8.3	7,100
2,2' -azino bis(3-ethylbenzthiazoline-6-sulphonic acid)	0	-	11.5	5,710
Promethazine Hydrochloride	0	-	0	-
Chlorpromazine Hydrochloride	0	-	0	-

"-" means that polymerization yield is almost zero and thus, mean molecular weight could not be determined (if necessary, this data can be presented in declaration form)

When combined with the data from Table 3 of the applicants' specification, the applicants have now shown six (6) structurally related phenothiazine mediator compounds which are outside the scope of the applicants' claims which fail to show the unexpected increase in yield shown by the applicants' claimed invention.

While the additional data is being provided to expedite prosecution, even without the additional data, it is noted that there is no set number of examples necessary for superiority to be established. *See MPEP 716.02(a), section II.; see also In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987). Since no countervailing evidence has been presented which asserts that unexpected results have not been shown, the applicants' claims are unobvious over the combination of Gijutsu and Sjøholm.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/
Marilyn M. Brogan Howard C. Lee
Reg. No. 31,223 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500